

### REMARKS

Claims 34-53 are pending in this application. Claims 34 and 50 are amended. Claims 34, 40, 43, 50, 51, and 52 are independent.

Claims 34-38, 40-47, and 49-53 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,699,528, hereafter referred to as Hogan.

Claims 39 and 48 stand rejected under 35 USC §103(a) as being obvious over Hogan in view of U.S. Patent No. 6,029,141, hereafter referred to as Bezos. The rejections, to the extent not addressed by the amendments, are respectfully traversed.

Prior traversal arguments are incorporated in their entirety.

Independent claims 34 and 50 require, *inter alia*, a transmission of a notice, according to an e-mail protocol, that indicates the availability of billing information, a transmission of a request, in response to the notice and according to a protocol other than an e-mail protocol, to receive the billing information, and a transmission of billing information in response to the request.

As discussed in prior the prior Amendment, dated August 13, 2003, Hogan discloses two embodiments of an electronic bill presentment service. In both embodiments, a bill image is received from a biller and formatted for presentation (see, for example, column 4, lines 53-67, column 5, lines 53-57, and column 9, lines 50-53). In the first embodiment, a subscriber retrieves the stored billing information from the bill service via the World Wide Web (see, for example, column 2, lines 32-35), and in the second embodiment, the stored billing information is transmitted to the subscriber as an e-mail message by the bill service (see, for example, column 2, lines 48-50).

The Examiner points to column 5, lines 53-61, of Hogan as teaching the transmission of a notice of bill availability according to an e-mail protocol. The Examiner-referenced text discloses transmitting an e-mail message to a subscriber only if both of two conditions are met. According to Hogan, this e-mail will only be sent if the subscriber has not logged on to the bill service **and** a bill is due within a predetermined period of time. Thus, the Examiner-referenced text does not disclose an e-mail notice of availability of billing information, but rather discloses a notice sent to inform a subscriber of a pending bill due date.

Furthermore, Hogan is silent as to any activity that may or may not occur after the transmission of this e-mail. Thus, Hogan also does not teach or suggest transmission of a request for billing information in response to a notice of availability of billing information, or transmission of at least a portion of the billing information in response to receipt of the request, as required by claims 34 and 50.

However, in the interest of passing the application to allowance, independent claims 34 and 50 have been amended to explicitly recite that the email notice of availability is transmitted irrespective of a bill due date. As should be clear from the discussion above, Hogan only transmits an e-mail when a bill is due within a predetermined time and a subscriber has not logged onto the Hogan system.

Accordingly, it is respectfully requested that the Examiner withdraw the rejection of independent claims 34 and 50, as well as claims 35-39 which depend from claim 34.

Further regarding independent claim 50, Hogan does not disclose a first network server configured to transmit to a subscriber via an e-mail protocol, and a second network server configured to receive from the subscriber via a protocol other

than e-mail. Rather, as seen in Figure 1, Hogan discloses a single server (detail 160) for communicating with a subscriber. The Examiner, in responding to previous traversal arguments, contends, "Hogan clearly teaches an e-mail server in addition to server computer 160" (paper no. 13, page 8, section 6). It is respectfully submitted that the Examiner is mistaken. Hogan only discloses a single server for all communications with a subscriber. To the extent that the Examiner maintains the position that the required first and second server computers are disclosed in Hogan, it is requested that the Examiner point out where in Hogan such is disclosed.

Independent claims 40 and 51 require, *inter alia*, transmission of an e-mail that indicates availability of billing information, transmission of an e-mail request to receive the billing information responsive to the notice, and transmission of billing information responsive to the request. The Examiner repeats the previous arguments in rejecting claims 40 and 51, and fails to even address prior traversal arguments regarding these claims, notwithstanding a request for the Examiner to provide rationale for reliance upon Figures 10 and 11.

As discussed in the prior response, Examiner-referenced Figure 1 shows a subscriber's computer (detail 100) in communication with a bill service computer (detail 160) via the Internet. Additionally, Figure 1 shows the bill service computer in communication with a bill capture device (detail 150), which is in communication with multiple payee (biller) computers (details 107-1 through 107-k). Figure 10 depicts a user presentation of summary bill information, including payee name, amount, and due date, for unpaid bills transmitted to a subscriber via e-mail, and Figure 11, depicts a user presentation of a full bill transmitted to a subscriber via e-mail.

Column 9, lines 7-19, which is directed to the second Hogan embodiment, discloses the bill service transmitting an e-mail message that includes formatted bill data. As disclosed in column 9, lines 50-54, the bill service receives billing data from a payee, formats the billing data in the form of an e-mail, and then transmits the e-mail (bill) to the subscriber's e-mail address. Thus, this e-mail is not a **notice of availability of billing information**, as required by claims 40 and 51, but rather **the billing information itself**.

The Examiner points to column 9, lines 61-64, as disclosing the required transmission of an e-mail request to receive the billing information. This Examiner-referenced text discloses that whenever a subscriber opens an e-mail to view a bill, an acknowledgement message is transmitted to the bill service indicating such. This acknowledgement message is transmitted "[u]tilizing a standard receipt confirmation feature of the e-mail service" (column 9, lines 61-62). This acknowledgement message is in no way an e-mail request to receive available billing information, as required by claims 40 and 51. This is especially true in light of the fact that billing information has **already been delivered** to the subscriber as an e-mail message prior to transmission of the acknowledgement message, which itself can only be transmitted after a subscriber opens the e-mail containing the billing information.

Finally, the Examiner points to Figures 10 and 11 as disclosing transmission of billing information responsive to a request for such. The Examiner's position is still not understood, as Figures 10 and 11 are each representations of information that can be displayed on a subscriber's computer **only after** billing information has been transmitted to the subscriber via e-mail. Furthermore, the second embodiment

of Hogan discloses that a notice of a pending bill due date is transmitted to the subscriber via regular mail, not e-mail (column 10, lines 9-12).

As should be understood from the above and prior traversal arguments, Hogan discloses two embodiments. In the first, billing information is delivered to a subscriber via a protocol other than e-mail, a subscriber's request for billing information is delivered via a protocol other than e-mail, and a notice of a pending bill due date is delivered to a subscriber via an e-mail protocol only if a bill is due within a certain time frame. In the second, billing information is delivered to a subscriber via an e-mail protocol, and a notice of a pending bill due date is delivered to a subscriber via regular mail, not electronically, only if a bill is due within a certain time frame. The subscriber never requests billing information in the second embodiment, as the billing information is pushed to him via e-mail. The Examiner-referenced portions of Hogan are directed to the second embodiment.

Accordingly, Hogan does not teach or suggest transmission of an e-mail notice of availability of billing information, and transmission, in response to the e-mail notice, of an e-mail request to receive the available billing information.

In view of the above, it is respectfully requested that the Examiner reconsider and withdraw the 35 USC §102(b) rejection of independent claims 40 and 51, as well as claims 41 and 42, which depend from claim 40.

Independent claims 43 and 52 require, *inter alia*, a notice indicating availability of billing information transmitted according to a network protocol other than e-mail, a request to receive the billing information transmitted responsive to the notice and also according to a network protocol other than e-mail, and a transmission of billing

information responsive to the request. The Examiner repeats the previous grounds of rejection of claims 43 and 52.

In responding to prior traversal arguments, the Examiner contends, "a notice is merely used to bring attention to a particular subject. ... By allowing the user to receive and pay bills (detail 203) the system is in fact bringing to the user's attention the billing information available." (paper no. 13, page 9, section 8).

It is respectfully submitted that while the home page of Figure 3, to which the Examiner references, does contain a link (detail 203) from which billing information might be accessed, the home page does not include a notice indicating **availability of billing information**. Rather, the link is present whether or not billing information is available. In order for this link to be a notice of available billing information, this link would have to be selectively displayed, i.e., only presented when billing information is available.

Hogan in no way teaches or suggests that this link is selectively displayed. Rather, with reference to column 4, lines 14-22, Hogan teaches that detail 203 of the home page of Figure 3 is always displayed. Thus, Hogan in fact teaches against the home page of Figure 3 being a notice of available billing information, as detail 203 "receive and pay bills" is always present, irrespective of billing information being available.

In view of the above, it is respectfully requested that the Examiner reconsider and withdraw the 35 USC §102 rejection of independent claims 43 and 52, as well as claims 44-49, which depend from claim 43, and claim 53, which depends from claim 52.

The dependencies of independent claims 34, 40, 43, and 53 recite further features that are not disclosed or suggested by Hogan. For example, dependent claims 35, 41, and 44 require formatting of billing information for presentation in response to receipt of the request for billing information. To repeat from prior traversal arguments, Hogan clearly teaches that billing information received from a biller is formatted by the bill service **as soon as** that information is received (see column 5, lines 53-57, and column 9, lines 50-54), **not** responsive to a request to receive the billing information.

The Examiner does not address this fact in the most recent Official Action. Rather, the Examiner continues to point to Figure 11 as disclosing the required feature and contends that “[t]he claim doesn’t recite that the bill is formatted on the fly.” The Examiner also points to column 5, line 62, through column 6, line 31, and further argues that the disclosed bill presentation to a user via a website somehow teaches the requirements of these claims (paper no. 13, page 8, section 7).

The Examiner is correct in noting that the claim does not recite “on the fly.” However, the clear and unambiguous language of the claim clearly does require that billing information be formatted for presentation in response to receipt of the request to receive the billing information, the request transmitted in response to the notice of availability. The Examiner-referenced text does not even address formatting. It seems that the Examiner has completely ignored the express limitations of these claims and the prior traversal arguments. The requirements of claims 35, 41 and 44 are simply not taught or suggested by Hogan.

Claims 37 and 46 require that the notice include information indicating a location of the available billing information. Claims 38 and 47 require that the

information indicating the location be a hyper-link, and that the hyper-link is selected to transmit the request. As should be clear from the prior traversal arguments, Hogan does not disclose the inventions recited in claims 37, 38, 46 and 47. The Examiner continues to point to column 4, lines 14-22, and column 5, line 44, through column 6, line 30, as disclosing these features. However, the Examiner has yet to point to any portion of Hogan that teaches or suggests a notice of availability indicating a location of available billing information.

Regarding the 35 USC §103(a) rejection of dependent claims 39 and 48, the Examiner acknowledges that Hogan does not teach the requirement that a hyper-link indicating a location of available billing information included in a notice of availability of billing information be an icon. The Examiner looks to Bezos for an icon. Bezos is directed to selling goods via the Internet, not electronic presentment of billing information. Bezos teaches a user selectable icon to link to a merchant's Web site.

It is respectfully submitted that in rejecting claims under 35 U.S.C. §103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In so doing, the Examiner is required to make the factual determination set forth in Graham v. John Deere Co. of Kansas City (148 USPQ 459 (1966)), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine the prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or inference in the prior art as a whole. It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the Applicants' disclosure at his side, and determine, in light of all the objective evidence bearing on



the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious.

It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986)). In determining the issue of obviousness, we must look to the collective teachings of the references relied upon and to whether the hypothetical person of ordinary skill in the art, familiar with such teachings would have found it obvious to make a corresponding structure or process to that being claimed (See In re Fritch (23 USPQ 1780 (Fed. Circ. 1992))).

The test for combining references is not what the individual references themselves suggest, but rather what the combination of disclosures taken at a whole would suggest to one of ordinary skill in the art.

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Obviousness cannot be properly established by simply showing that each claimed element may be found somewhere in the prior art (See Hartness International, Inc. v Simplimatic Engineering Co. (2 USPQ 2<sup>nd</sup> 1826 (Fed. Circ. 1987))). Without a suggestion of the invention in the prior art reference combination, there is no motivation to combine the references. Simplicity and hindsight are not proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967))). The mere possibility that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification in the absence of such a

suggestion the basis for the rejection can only be viewed as nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski 230 USPQ 313 (Fed. Circ. 1986)).

The issue is not whether it is within the skill of the art to make the proposed modifications, but rather one skilled in the art, on consideration of the references, would have found it obvious to do so. It should be recognized that the fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification (See In re Gordon 221 USPQ 1125 (Fed. Circ. 1984)), and (In re Keller 208 USPQ 817 (CCPA 1981)).

It is respectfully submitted that the Examiner's basis for the obviousness rejection is not based on what the prior art shows, teaches or suggests, but rather by whether, in the Examiner's view, one of ordinary skill could have found the invention easy to conceive. Such a position is unsupported by any case law, and such simplicity and hindsight are not proper criteria for resolving obviousness (See In re Warner, supra). It is further respectfully submitted that there is nothing within any of the applied art teachings which would suggest the Examiner's proposed modification to Hogan to arrive at the invention of claims 39 and 48. Rather, there is nothing within Hogan to suggest that a hyper-link should be an icon. Bezos is directed to internet commerce, not electronic bill presentment. Bezos in no way suggests combining its disclosure with an electronic bill presentment system. Hence, one can only ask what in the applied prior art suggests modifying Hogan as proposed on the basis of the disclosure of Bezos. As the Federal Circuit recently reiterated, if there is no suggestion or motivation to combine the references in the prior art itself, there is no basis for the combination.

Reliance on common knowledge and/or common sense cannot be the basis of finding obviousness (See In re Lee 61 USPQ 2<sup>nd</sup> 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sense. Accordingly, it is respectfully submitted that claims 39 and 48 distinguish over the prior art for reasons which should be clear from the above and from prior traversal arguments.

For at least these reasons, it is respectfully requested that the Examiner reconsider and withdraw the rejections of the dependent claims.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

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PATENT

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 (1158.41315CC4) and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



Sterling W. Chandler  
Registration No. 51,370

1300 N. 17th Street  
Suite 1800  
Arlington, VA 22209  
Telephone: (703) 312-6600  
Fax: (703) 312-6666  
E-Mail: schandler@antonelli.com  
Date: February 3, 2003

SWC